

DETAILED ACTION

Reissue Applications

1. Claims 122, 124-138, 140-146 rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The "patent claims," in the context of recapture case law, are claims which issued in the original patent for which reissue is now being sought. Reissue claims that are broader than the original patent claims by not including the surrender-generating limitation will be barred by the recapture rule even though there is narrowing of the claims not related to the surrender-generating limitation. As stated in the decision of *In re Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165, if the reissue claim is broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim. *Pannu*

Art Unit: 3611

v. Storz Instruments Inc., supra, then brings home the point by providing an actual fact situation in which this scenario was held to be recapture.

In parent application 09/531,565, in the amendment filed 15 May 2001, it was argued on pages 8-10 that the following limitations read over the prior art:

“The Files reference does not show or disclose the elements of the second actuator having a second rod end fixed to the plate as claimed in the present invention.”

“The Files patent also lacks the element of the first articulation means being for moving the chassis with respect to a fixed point on the frame in order to move the rear support inward of the frame, as claimed in the present invention.”

“The Files device also fails to show or disclose the element of the first actuator having a first hydraulic jack with a first rod end fixed to the yoke, as presently claimed.

“New claims 12-14 are patentable over the cited prior art of record because the prior art lacks a steerable machine having a pair of rollable front supports that are rotatable about a front vertical axis and are controlled by power steering. The prior art also lacks a pair of rollable rear supports that are pivotable about a rear vertical axis and are controlled by a steering hydraulic cylinder.

The above underlined limitations constitute surrendered subject matter.

Since claims 122, 124-138, 140-146 omit the above noted limitations argued for the patentability of claims 1-10, as well as claims 12-14, claims 122, 124-138, 140-146 are barred by the recapture rule.

Art Unit: 3611

2. Note that a statement under 37 CFR 1.173(c) is required. The statement must provide an explanation of the support in the disclosure of the patent for the changes made to the all of the claims. Each underlined limitation is considered a change and should correspond to a specific column and line number to the original patent.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 10-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 10 line 9 “said solenoid valves” lacks proper antecedent basis.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by Miller et al.
4,029,165.

Miller et al. discloses a steerable machine comprising:

Art Unit: 3611

a frame 12;

at least one pair of rollable front supports 140, said front supports being rotatable about a front vertical axis 122 and front steering means 160,162 controlled by power steering for steering said front supports;

at least one pair of rollable rear supports 140, said rear supports being pivotable about a rear vertical axis 122a and rear steering means controlled by at least one steering hydraulic cylinder 190,192 for steering said rear supports;

at least one driver's cab 30 located in said frame (front and rear ;

a means for breaking up the ground 350 connected to said frame; traction means supported by said frame for rotating at least one of said rollable supports;

a maneuvering system 412 accessible from said driver's cab for operating said front steering means and said rear steering means at the same time, from said driver's cab;

said front steering means is comprised of a second actuator having a hydraulic steering cylinder 160 supplied by slide valves 412 for working with said front supports;

said rear steering means is comprised of a first actuator having a steering hydraulic cylinder 190 supplied by slide valves 412 for working with said rear supports;

and said maneuvering system having a control means interlinking said steering hydraulic cylinders, and controlling coordinated turning of both said front supports and said rear supports;

said control means further comprises potentiometric position detectors 342,344 in mechanical connection with each steering hydraulic cylinder, and electrically connected to an electronic control unit.

Art Unit: 3611

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al. '165 in view of Swisher, Jr. 5,190,398.

Miller et al. discloses the claimed invention except it appears to use levers to steer the vehicle instead of a steering wheel.

However, it is old and known in the art, for example as shown by Swisher, Jr., to use a steering wheel 184 to steer a vehicle.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Miller et al. by using a steering wheel to steer the vehicle in place of levers, as taught by Swisher, Jr., the two being art recognized equivalents.

Allowable Subject Matter

9. Claims 1-8 would be allowable upon the filing of an acceptable reissue declaration.

Response to Arguments

10. Applicant's arguments with respect to claims 122-146 have been considered but are moot in view of the new ground(s) of rejection.

Note, that since the previous response, the law regarding recapture in instances of "an

Art Unit: 3611

overlooked aspect of the invention” has been clarified. Specifically, in *In re Mostafazadeh*, No. 10-1260 (Fed. Cir. May 3, 2011), the Federal Circuit has clarified that a limitation added during prosecution to overcome a prior art rejection, cannot be eliminated on reissue as such would constitute recapture of the surrendered subject matter. An unclaimed embodiment only avoids recapture if it is wholly unrelated to the originally claimed invention.

The following claim would be allowable over the prior art and has been reviewed by the 3600 SPRE for recapture issues. It is based on original patent claim 1 but has been amended to read on the embodiment where only one rear rollable support is steered. Surrendered subject matter is italicized.

(proposed new claim) A steerable machine for breaking up ground comprising:

a frame;

at least one pair of rollable front supports and at least one pair of rollable rear supports, each of said front and rear supports including a chassis secured to the frame and said front supports being rotatable about a front vertical axis and **[at least]** one of the rear supports being a rear steerable support pivotable about a rear vertical axis;

said chassis includes a yoke that supports said rear steerable support, and has a vertical

pivot journal coupled to revolve on a support plate fixed to an end of a second actuator;

said second actuator comprises a second hydraulic jack set with a vertical axis, which has a second rod with a second rod end fixed to said plate and a second cylinder end, wherein said rod slides, integral with said frame;

the cylinder of said second hydraulic jack is an integral part of said frame being

Art Unit: 3611

connected thereto by means of *a first articulation for moving said chassis with respect to a fixed point on said frame in order to move the rear steerable support inward of said frame;*

at least one driver's cab located in said frame;

a means for breaking up the ground connected to said frame;

traction means supported by said frame for rotating at least one of said rollable supports;

at least one first actuator operatively coupled to the rear steerable support[s];

a maneuvering system accessible from said driver's cab for operating the

actuator for rotating said rear steerable support[s] about the rear vertical axis while turning the front supports of the machine.

Reissue Oath/Declaration

11. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 1-11, 122, 124-138, 140-146 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

“Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant.”

See MPEP § 1414.01.

The new reissue oath will require a new error statement reflecting any errors in claim scope.

Art Unit: 3611

The new reissue declaration should include the change of inventorship as an error as required by MPEP 1412.04 which states " The reissue oath or declaration pursuant to 37 CFR 1.175 must state that the applicant believes the original patent to be wholly or partly inoperative or invalid through error of a person being incorrectly named in an issued patent as the inventor, or through error of an inventor incorrectly not named in an issued patent, and that such error arose without any deceptive intention on the part of the applicant."

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN HURLEY whose telephone number is (571)272-6646. The examiner can normally be reached on Monday-Friday 9:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3611

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KEVIN HURLEY/
Primary Examiner, Art Unit 3611

October 26, 2011